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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/635,362

08/05/2003

Rob Falke

40055-0001

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20480

7590

02/12/2008

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SUITE 150

SOUTH JORDAN, UT 84095

EXAMINER

WILKENS, JANET MARIE

ART UNIT

PAPER NUMBER

3637

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/635,362	<b>Applicant(s)</b> FALKE, ROB	
	<b>Examiner</b> Janet M. Wilkens	<b>Art Unit</b> 3637	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15, 28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 28 and 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15, 28 and 30-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Namely, there is nothing in the specification that says that the furniture is manufactured and then purchased. The step that “manufacturing said piece of furniture to be sold to a purchaser for whom said piece of furniture will become said heirloom” is not discussed or clearly implied.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Exhibit A (with affidavit). The exhibit teaches a piece of furniture made of wood, and inherently a method comprising preparing one or more handwritten writings, i.e. a signature, by hand directly on the

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wood of which said piece of furniture is made, and storing the handwritten writings on the piece of furniture, wherein the furniture comprises a member comprising a surface of the wood that is specifically configured to permanently receive said handwritten writings (wood which is capable of being carved/marked on). Namely, as stated in the affidavit, after constructing the wooden nightstand, the artisan, Donald Wiehe wrote his name in the side/plank of the extendable drawer. Since this is Ms. Wiehe-Kaylor's father, this piece of furniture is undoubtedly considered an heirloom to her. Note: although this piece of furniture was manufactured in shop class, the artisan/school purchased the materials making the piece of furniture first. After construction, the writing was added. Also if Ms. Weihe-Kaylor decided to sell this article of furniture, the unwritten on wood portions could be written on by the new owner if desired. Even if the method step of manufacturing is limited to completed furniture pieces, the examiner contends that any wooded piece of furniture made or bought can be written on and then passed to heirs. Wood material and wood carving instruments allowing any type of writing thereon. Please also note: that in the disclosed specification, page 1, paragraph 003, handcrafted furniture, such as is taught by the Exhibit, is stated as a type of furniture for the claimed "writing on" process. The examiner considers this type of furniture functionally equivalent to store bought furniture.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 28, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robie (788,946) in view of Wagner (977,349) and Exhibit A. Robie teaches a piece of furniture (Fig. 1) and inherently a method comprising preparing and storing handwritten writings on the piece of furniture (drawer covers/planks capable of being printed/written on), wherein the furniture comprises a member comprising a surface (13) that is specifically configured to permanently receive said handwritten writings (15). Under the writings are items related thereto. For claims 1 and 28, Robie fails to teach that the cabinet is specifically made of wood. However, as shown by Wagner, wooden furniture with a drawer (5) having a cover/plank (7) is well known in the art. Also, the examiner takes Official notice that carving wood using wood carving utensils is well known in the art. (see also Board decision of June 8, 2007 on page 14) Furthermore, as stated above in the Exhibit rejection, writing on wooden furniture for personal/heirloom purposes is well known. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to make the cabinet of Robie out of wood, such as is taught by Wagner, for aesthetic reasons, for economic reasons, depending on materials readily available, etc. Also, it would have been obvious to make the markings (15) on the surface using the desired utensil and to add any type of markings as desired (see Exhibit). (For claims 28 and 33, see Board decision of June 8, 2007, pages 19-20) As for the fact that is not stated that this piece of furniture was purchased and then written on for heirloom purposes, the examiner

contends that since the Exhibit teaches writing a family name on wooded furniture, any wooden piece of furniture made or bought could inherently be written on by its owner and then passed to his heirs as stated in this case. There is nothing unique about the materials/piece of furniture itself in the claims; therefore, having one write desired information on a wooden surface would have been an obvious consideration.

For claims 2, 14 and 15, Robie in view of Wagner and exhibit A fails to teach markings/parallel grooves etched in the plank. However, the use of lines on members to aid in adding written material thereon (so that the words/letters are written in a straight line) is well known in the art. Therefore, to etch such grooves in the planks of Robie in view of Wagner, would have been an obvious design consideration, for the advantage stated above. (Note: this Official notice was upheld by the Board in the decision of June 8, 2007)

Furthermore for claims 9-11 and 30-32, adding a family tree, pedigree chart, signature, date(s), stamps, specific historical event, time etc. on the plank would have been an obvious consideration to one of ordinary skill in the art, depending on the desired need of the person preparing the cabinet, its intended use, etc. (Note: see Board decision of June 8, 2007 pages 17-19 wherein this Official notice was upheld.)

Claims 1-15, 28, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (977,349) in view of Robie (788,946) and Exhibit A. Wagner teaches a piece of furniture (Fig. 1) and inherently a method comprising preparing and storing handwritten writings on the piece of furniture, wherein the furniture comprises a member comprising a surface (7) that is specifically configured to permanently receive

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said handwritten writings (made of wood so inherently can be written on). Under the panel, in the drawer, can be placed items related to the writings. For claims 1 and 28, Wagner fails to specifically teach writings on the plank. Robie teaches having writings (15) on plank portions (13) of a drawer (11). Also, the examiner takes Official notice that carving wood using wood carving utensils is well known in the art. Furthermore, as stated above in the Exhibit rejection, writing on wooden furniture for personal/heirloom purposes is well known. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the furniture piece of Wagner adding writing onto its plank, such as is taught by Robie, for informational purposes, or such as taught by exhibit A for heirloom purposes, for aesthetic purposes, etc. Also, it would have been obvious to make the markings on the surface using the desired utensil and to add any type of markings as desired (see Exhibit). (For claims 28 and 33, see Board decision of June 8, 2007, pages 19-20) As for the fact that is not stated that this piece of furniture was purchased and then written on for heirloom purposes, the examiner contends that since the Exhibit teaches writing a family name on wooded furniture, any wooden piece of furniture made or bought could inherently be written on by its owner and then passed to his heirs as stated in this case. There is nothing unique about the materials/piece of furniture itself in the claims; therefore, having one write desired information on a wooden surface would have been an obvious consideration.

For claims 2, 14 and 15, Wagner in view of Robie and Exhibit A fails to teach markings/parallel grooves etched in the plank. However, the use of lines on members to aid in adding written material thereon (so that the words/letters are written in a

straight line) is well known in the art. Therefore, to etch such grooves in the planks of Wagner in view of Robie and exhibit A, would have been an obvious design consideration, for the advantage stated above.

Furthermore for claims 9-11 and 30-32, adding a family tree, pedigree chart, signature, date(s), stamps, specific historical event, time etc. on the plank and storing related items in the drawer would have been an obvious consideration to one of ordinary skill in the art, depending on the desired need of the person preparing the cabinet, its intended use, etc.

### ***Response to Arguments***

Applicant's arguments filed November 30, 2007 with respect to claims have been considered but are not persuasive.

Addressing the argument concerning the heirloom feature now stated in the claims: the examiner contends that this limitation is merely intended use. That writing any type of material on a wooden member is well known in the art (see Board decision page 12). Furthermore it is known to write names, etc. on wooden furniture handmade (see Exhibit A) or bought (see a high school student classroom desk top for example). The handmade furniture taught in Exhibit A inherently being considered an heirloom by its present owner as could any piece of furniture with personal writing added thereon. In Wagner/Robie and Robie/Wagner, although it is not stated when the writing was added to its plank, to add such a feature after purchase would have been an obvious scenario, for customization reasons.



Furthermore, please see Board decision of June 8, 2007 wherein the examiner's art rejection positions were affirmed. A Board decision in an application is the "law of the case"/has a resjudicata effect and is thus controlling in the application and any subsequent related application. See MPEP 1214.01. No further review or remarks will be made concerning these portions, e.g. the Official notice portions, of the rejections.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet M. Wilkens whose telephone number is (571) 272-6869. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janet M. Wilkens/  
Primary Examiner, Art Unit 3637

Wilkens  
February 6, 2008